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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/015,381
Filing Date: December 12, 2001
Appellant(s): BROWN ET AL.

H. Artoush Ohanian
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 12, 2005 appealing from the Office action mailed July 06, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 31-41.

Claims 1-30 and 42-47 were withdrawn from consideration as not directed to the elected group.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

6,430,276	Bouvier et al.	08-2002
2003/0081744	Gurfein et al.	05-2003
6,556,127	Moser et al.	04-2003
2002/0184096	Kawahara et al.	12-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the Appellant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the Appellant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 31, 33, 35, 37, 39 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Bouvier et al. (U.S. Patent No. 6,430,276).

Regarding claim 31, Bouvier teaches receiving, at the service control subsystem, a Personal Identification Number (PIN) for a call request from a customer telephone (abstract; fig.1; col.5, line 65-col.6, line 13; ‘service control subsystem’ reads on the claimed ‘an

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intermediary device', 'Personal Identification Number (PIN)' reads on the claimed 'authenticated caller identity' and 'customer telephone' reads on the claimed 'origin device').

Bouvier further teaches retrieving the customer profile (i.e., caller profile) for the Personal Identification Number (PIN) (col.5, line 65-col.6, line 13 of Bouvier teaches that a particular customer is identified by his PIN, and his profile is retrieved after being identified by SCP of service control subsystem.).

Bouvier further teaches specifying a selection of services from among a plurality of services that are offered for the call request according to the customer profile (col.6, lines 11-16). (Note: each particular customer has subscribed a list of access service providers and each profile includes the list. Therefore, it is clear that a selection of services from among a plurality of services are offered for a call request according to each particular customer profile.)

Regarding claims 33, 37 and 40, Bouvier teaches retrieving the caller profile from a database 50 [i.e., profile database] within the service control subsystem (fig.1; col.6, lines 11-16).

Claim 35 is rejected for the same reasons as discussed above with respect to claim 31. Furthermore, Bouvier teaches the service control subsystem [i.e., intermediary device] communicatively connected to a telephone network (fig.1).

Claim 39 is rejected for the same reasons as discussed above with respect to claim 31. Furthermore, Bouvier teaches a database 50 (fig.1; col.6, lines 11-16; 'database' reads on the claimed 'recording medium').

3. Claims 31, 35 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Gurfein et al. (U.S. Pub. No. 2003/0081744).

Regarding claim 31, Gurfein teaches receiving, at the telephone entertainment system, a PIN number for a call request from a caller telephone (fig.1; page 3, paragraph 0065; ‘telephone entertainment system’ reads on the claimed ‘an intermediary device’, ‘PIN number’ reads on the claimed ‘authenticated caller identity’ and ‘caller telephone’ reads on the claimed ‘origin device’). (Note: it is inherent that caller is using a telephone to make the above call request.)

Gurfein further teaches retrieving the caller profile for the PIN number (Page 3, paragraph 0065 of Gurfein teaches that a particular caller is identified by his PIN and his profile is retrieved after being identified by the telephone entertainment system.).

Gurfein further teaches specifying a selection of telephone shows [i.e., services] from among a plurality of telephone shows that are offered for the call request according to the caller profile (page 3, paragraphs 0065, 0066, 0071). (Note: each particular caller of Gurfein has subscribed a list of telephone shows and each profile includes the list. Therefore, it is clear that a selection of telephone shows from among a plurality of telephone shows are offered for a call request according to each particular caller profile.)

Claim 35 is rejected for the same reasons as discussed above with respect to claim 31. Furthermore, Gurfein teaches the telephone entertainment system [i.e., intermediary device] communicatively connected to a telephone network (fig.6, 7; page 10, paragraph 0163).

Claim 39 is rejected for the same reasons as discussed above with respect to claim 31. Furthermore, Gurfein teaches a database 50 (page 4, paragraph 0074; ‘database’ reads on the claim ‘recording medium’).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouvier et al. (U.S. Patent No. 6,430,276) in view of Moser et al. (U.S. Patent No. 6,556,127).

Bouvier teaches all the limitations of parent claims 31 and 35.

Regarding claims 32 and 36, Bouvier does not specifically teach “said authenticated caller identity is authenticated by a voice utterance of said caller”. Moser teaches that the authenticated caller identity is authenticated by a voice utterance of the caller (col.3, lines 57-67). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bouvier to allow the authenticated caller identity being authenticated by a voice utterance of the caller as taught by Moser. The motivation for the modification is to do so in order to provide the option of orally entering the subscriber identification.

6. Claims 34, 38 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouvier et al. (U.S. Patent No. 6,430,276) in view of Kawahara et al. (U.S. Pub. No. 2002/0184096).

Bouvier teaches all the limitations of parent claims 31, 35 and 39.

Regarding claims 34, 38 and 41, Bouvier fails to teach “retrieving said caller profile from a systems management server”. Kawahara teaches retrieving the user personal information from

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the user management server (page 13, paragraph 0239; 'user personal information' reads on the claim 'caller profile' and 'user management server' reads on the claim 'systems management server'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bouvier to allow retrieving the caller profile from the systems management server as taught by Kawahara. The motivation for the modification is to do so in order to provide various services as desired by the caller.

(10) Response to Argument

Claims 31,33,35,37,39 and 40

Ia: On pages 4,6,8,9 of the Appeal Brief, the Appellant contends that Bouvier does not disclose "A method for specifying telephone services for a particular caller, comprising: receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device; retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile". The examiner respectfully disagrees with this argument for the following reasons:

Bouvier teaches receiving, at the service control subsystem, a Personal Identification Number (PIN) for a call request from a customer telephone (abstract; fig.1; col.5, line 65-col.6, line 13; 'service control subsystem' reads on the claimed 'an intermediary device', 'Personal

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Identification Number (PIN)' reads on the claimed 'authenticated caller identity' and 'customer telephone' reads on the claim 'origin device');

retrieving the customer profile [i.e., caller profile] for the Personal Identification Number (PIN) (col.5, line 65-col.6, line 13);

specifying a selection of services from among a plurality of services that are offered for the call request according to the customer profile (col.6, lines 11-16). In light of col.6, lines 11-16, each particular customer has subscribed a list of access service providers and each profile includes the list. Therefore, it is clear that a selection of services from among a plurality of services are offered for a call request according to each particular customer profile.

Since user is provided with different access options through telephone from which he/she can make a choice and each of user's choice corresponds to a network access server (col.7, lines 39-50), the 'different access options through telephone' is the claimed 'specifying telephone services'. Thus the rejection of the claims in view of Bouvier is proper.

On page 6, of the Appeal Brief, the Appellant further contends that the cited sections of Bouvier do not even address authenticated caller identities, call requests, or specifying telephone services for a particular caller at all. Examiner respectfully disagrees with this argument. Bouvier teaches that a particular customer is identified by his PIN and his profile is retrieved after being identified by SCP of service control subsystem (col.6, lines 7-16, col.7, lines 9-31).

On pages 6 and 7 of the Appeal Brief, the Appellant further contends, the rejection admits that Bouvier does not disclose specifying a selection of services from among a plurality of services that are offered for said call request as claimed in claim 31. Examiner respectfully disagrees with this argument. No such admission was made in the rejection.

Ib: On pages 10 and 11 of the Appeal Brief, the Appellant contends that Figure 1 does not disclose receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device as claimed in the present invention. Examiner respectfully disagrees with this argument. The Appellant didn't claim the actual physical location of intermediary device and origin device. The service control subsystem of Bouvier reads on the claimed 'intermediary device' and the customer telephone reads on the claimed 'origin device'. It is because, the service control subsystem receives a Personal Identification Number (PIN) for a call request from a customer telephone (col.5, line 65-col.6, line 13, col.7, lines 9-31).

Claims 31, 35 and 39

IIa: On pages 10-16 of the Appeal Brief, the Appellant contends that Gurfein does not disclose "A method for specifying telephone services for a particular caller, comprising: receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device; retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile". The examiner respectfully disagrees with this argument for the following reasons:

Gurfein teaches receiving, at the telephone entertainment system, a PIN number for a call request from a caller telephone (fig.1; page 3, paragraph 0065; 'telephone entertainment system'

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reads on the claimed 'an intermediary device', 'PIN number' reads on the claimed 'authenticated caller identity' and 'caller telephone' reads on the claimed 'origin device');

retrieving the caller profile for the PIN number (Page 3, paragraph 0065 of Gurfein teaches that a particular caller is identified by his PIN and his profile is retrieved after being identified by the telephone entertainment system.);

specifying a selection of telephone shows [i.e., services] from among a plurality of telephone shows that are offered for the call request according to the caller profile (page 3, paragraphs 0065, 0066, 0071).

Since, based on caller profile each particular caller is presented a possible list of telephone shows/audio entertainment programs through telephone call after the system identifying caller's PIN number [i.e., authenticated caller identity] and the caller can make a choice from the list of telephone shows/audio entertainment programs (pages 3,4, paragraph 0065), the 'possible list of telephone shows/audio entertainment programs through telephone call' is the claimed 'specifying telephone services'. Thus the rejection of the claims in view of Gurfein remain.

On page 11, of the Appeal Brief, the Appellant further contends that paragraph 0065 does not even address authenticated call requests, or specifying telephone services for a particular caller at all. Examiner disagrees with this argument. The Appellant didn't claim authenticated call requests. Further, Gurfein teaches specifying a list of telephone shows/audio entertainment programs through telephone [i.e., telephone services] for a particular caller (pages 3,4, paragraph 0065).

On page 15 of the Appeal Brief, the Appellant further contends that a telephone show is not a telephone service. Examiner disagrees with this argument. The citation ‘telephone service’ is very broad. Since, Gurfein teaches selecting telephone shows/audio entertainment program through telephone (abstract; page 4, paragraph 0065), examiner considers selection of telephone shows/audio entertainment program through telephone as telephony services. Thus the rejection of the claim in view of Gurfein remain.

Claims 32 and 36

IIIa: On pages 17 and 19 of the Appeal Brief, the Appellant contends that “Bouvier discloses selecting a dialup access service provider for the caller”. The examiner agrees with this argument. However, the Appellant did not claim the limitation. Therefore, the argument is irrelevant.

IIIb: On pages 17 and 19 of the Appeal Brief, the Appellant further contends that “Moser does not however disclose specifying telephone services for a particular caller including receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device; retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile”. The examiner agrees with this argument. However, Examiner relied upon Moser for the teaching of ‘said authenticated caller identity is authenticated by a voice utterance of said caller’. Thus the rejection of the claim in view of Bouvier and Moser remain.

On page 18 of the Appeal Brief, the Appellant further contends that “The above reference in the Office Action does not point to any specific teaching in either Bouvier or Moser suggesting such a modification or combination”. The examiner respectfully disagrees with this argument. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bouvier provides the suggestion that the interaction between the user and the PSTN for authentication and access service selection involves directing voice messages to the user and voice feedback is collected from the user (col.11, lines 27-30).

Claims 34, 38 and 41

IVa: On page 19 of the Appeal Brief, the Appellant further contends that “Bouvier does not disclose specifying telephone services for a particular caller”. The examiner respectfully disagrees with this argument for the following reasons:

Since user is provided with different access options through telephone from which he/she can make a choice and each of user’s choice corresponds to a network access server (col.7, lines 39-50), the ‘different access options through telephone’ is the claimed ‘specifying telephone services’.

Thus the rejection of the claim in view of Bouvier and Kawahara should be sustained.

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IVb: On page 19 of the Appeal Brief, the Appellant further contends that “Kawahara is an unrelated disclosure of a portable terminal device aimed at immediately providing a consumer with advertising information about goods that the consumer finds on another person”. The examiner respectfully disagrees. Examiner relied upon Kawahara only for the teaching of retrieving said caller profile from a systems management server.

Thus the rejection of the claim in view of Bouvier and Kawahara remain.

On page 20 of the Appeal Brief, the Appellant further contends that “The above reference in the Office Action does not point to any specific teaching in either Bouvier or Kawahara suggesting such a modification or combination”. The examiner respectfully disagrees with this argument. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bouvier provides the suggestion that after authenticating user SCP retrieves the user profile data over the internet 30 from the server 55 (fig.3; col.8, line 64-col.9, line 13).

Thus the rejection of the claim in view of Bouvier and Kawahara remain.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Md. Shafiul Alam Elahee

Md Shafiul Alam Elahee

Examiner

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March 13, 2006

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